

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte FRANK L. GREENWAY

---

Appeal No. 95-4411  
Application No. 08/125,504<sup>1</sup>

---

ON BRIEF

---

Before JOHN D. SMITH, GARRIS and PAK, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

---

<sup>1</sup> Application for patent filed September 22, 1993. According to the appellant, the application is a continuation of Application No. 07/914,893, filed July 16, 1992, now abandoned, which is a continuation-in-part of Application No. 07/380,739, filed July 17, 1989, now abandoned, which is a continuation of Application No. 07/225,070, filed July 27, 1988, now abandoned, which is a continuation of Application No. 06/816,386, filed January 6, 1986, now abandoned, which is a continuation of Application No. 06/703,221, filed February 19, 1985, now abandoned.

Appeal No. 95-4411  
Application No. 08/125,504

DECISION ON APPEAL

This is an appeal<sup>2</sup> pursuant to 35 U.S.C. § 134 from the final rejection of claims 1 through 12.

Claim 8 is representative and is reproduced below:

8. A process for preparing a potato chip, the process comprising:

preparing a slice of fresh, undehydrated potato, the slice having a thickness of from about 1 to about 3 millimeters, the slice having no added fat and no added globular protein; and then

heating the slice in a microwave oven at a high intensity for a period of time sufficient to produce a product having

---

<sup>2</sup> This is appellant's third appeal to the Board involving subject matter relating to a process for preparing potato chips. In the Board's decision in the most recent appeal (Appeal No. 92-0573 entered February 25, 1992 in parent application 07/380,739, filed July 17, 1989), the Board expressed concern that appellant had not shown that microwave heating of potato slices absent any coating would result in a chip having a surface texture, shine and air pockets as associated with deep fat fried chips. See page 5 of the Board's decision. Although no rejection of any claim under the first paragraph of 35 U.S.C. § 112, enablement requirement was before that Board, and although no "enablement" rejection under 35 U.S.C. § 112, first paragraph, has been imposed against the presently appealed claims, appellant has provided evidence in this record which bears on this issue. Consistent with the decision of In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976), in deciding the issues raised in this appeal, we have reevaluated all of the evidence before us that affects the issues and arguments presented.

Appeal No. 95-4411  
Application No. 08/125,504

substantially the same flavor, color, and crispness as deep fat fried potato slices and having no added fat and no added globular protein.

Appeal No. 95-4411  
Application No. 08/125,504

The references of record relied upon by the examiner are:

Foerstner	4,190,756	Feb.
26, 1980		
Yuan et al. (Yuan)	4,283,425	Aug.
11, 1981		

The appealed claims stand rejected under 35 U.S.C. § 103 over Yuan. Additionally, claims 5 and 15 stand rejected under 35 U.S.C. § 103 over Yuan in view of Foerstner.

We do not sustain the stated rejections.

The subject matter on appeal comprises a process for preparing potato chips having no fat and no added globular protein coating. Appellant's process involves preparing thinly sliced (about 1 to about 3 millimeters), raw potatoes, and then cooking them in a microwave oven for a time sufficient to produce a chip having substantially<sup>3</sup> the same flavor, color and crispness as a deep fat fried potato slice. No added fat and no added globular protein is used in the claimed process. In

---

<sup>3</sup> The flavor, texture, and appearance of the chip should be at least as good as for existing potato chips, and the taste of the chip is said to be "essentially" equivalent to that of conventional deep fat fried potato chips. See the specification at page 5, lines 5-8 and page 6, lines 6-13.

Appeal No. 95-4411  
Application No. 08/125,504

contrast, the prior art reference to Yuan distinctly teaches and states that the use of a globular protein coating, preferably in conjunction with an oil coating and microwave cooking, is "essential" to produce a potato chip having the color and appearance, as well as crispness and flavor of conventional

deep oil fried potato chips. Thus Yuan teaches at column 3, lines 49-54 that

Since hot air oven processing of protein coated slices of raw potato does not yield a comparable product, it is thought that the combination of protein coating and microwave heating is essential to produce a low fat product which is so similar to deep fat fried potato chips. Apparently, the protein forms a translucent film which provides the chips with a slightly greasy appearance coupled with a fairly homogeneous texture and color. Further, the protein enables desirable air pockets to form on the surface of the potato slices during microwave heating [emphasis added].

The examiner has rejected appealed claims 1 through 12 as obvious over Yuan based on the rationale that it would have been obvious to eliminate the globular protein with its function from a dilute salt solution applied to the potato chip in Yuan's process, if a potato chip having no added protein and no air pockets on the surface thereof is desired.

Appeal No. 95-4411  
Application No. 08/125,504

See the office action entered August 18, 1994. However, the presence of air pockets on the surface chip is a desirable feature when one is attempting to duplicate the appearance and color of a conventional deep fat fried potato chip. Moreover, in the record before us, appellant has provided evidence in declaration form from expert food panelists, who found that chips produced by appellant's process possess an air bubble appearance. Moreover, that chips produced by appellant's process produce a product having "substantially the same flavor, color, and crispness as deep fat fried potato slices," at least to the same extent that chips formed by the Yuan process possess such characteristics is evident from the declaration evidence of record. See, for example, page 5 of the Weimer declaration.

While it is often been said that the mere omission of an element or step together with its function does not produce a patentable invention, it is also been held that it may be unobvious to omit an element while retaining its function. In re Edge, 359 F.2d 896, 899, 149 USPQ 556, 557 (CCPA 1966). Here, appellant has provided evidence that the elimination of a globular protein coating, as required by the prior art

Appeal No. 95-4411  
Application No. 08/125,504

method, does not destroy the utility of the claimed method to make potato chips that have an appearance very similar to the chips of Yuan and similar to deep fat fried potato chips.

Thus, appellant has eliminated an essential prior art step while retaining its

Appeal No. 95-4411  
Application No. 08/125,504

function. Under these circumstances, we agree with appellant  
that the stated rejection of the examiner cannot be sustained.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
CHUNG K. PAK	)	
Administrative Patent Judge	)	

jrg

Appeal No. 95-4411  
Application No. 08/125,504

DRUCKER & SOMMERS  
9465 Wilshire Blvd. Suite 328  
Beverly Hills, CA 90212

Appeal No. 95-4411  
Application No. 08/125,504

JENINE GILLIS

Appeal No. 95-4411  
Serial No. 08/125,504

Judge JOHN D. SMITH

Judge PAK

Judge GARRIS

Received: 11/25/98

Typed: 12/01/98

Revised: 12/02/98

DECISION: REVERSED

Send Reference(s): Yes No  
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1302

Index Sheet-2901 Rejection(s): \_\_\_\_\_

Acts 2: \_\_\_\_\_

Palm: \_\_\_\_\_

Mailed: Updated Monthly Disk (FOIA): \_\_\_\_\_

Updated Monthly Report: \_\_\_\_\_

Appeal No. 95-4411  
Application No. 08/125,504